

REMARKS

In the Office Action, the Examiner rejected claims 1-28. In view of the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected independent claims 1-13 and 15-28 under 35 U.S.C. 102(e) as anticipated by Babula et al. (U.S. Pat. No. 6,381,557).

Applicants respectfully traverse this rejection in view of the following legal precedent and remarks.

Legal Precedent

First, when construing claims, the Federal Circuit has consistently looked first to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03:

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

The *Texas Digital* court further stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” *Id.* at 1204 (cited with approval in *Intellectual Property Development*

Inc. v. UA-Columbia Cablevision of Westchester Inc., 67 U.S.P.Q. 2d 1385, 1389 (Fed. Cir. 2003)).

Second, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Third, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other

limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Fourth, the *drawings* of the cited reference must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (CCPA 1979).

Features of Independent Claim 1 Omitted from Babula et al.

The Examiner rejected independent claim 1 and dependent claims 2-13 under 35 U.S.C. 102(e) as anticipated by Babula et al. Claim 1 recites:

A method of identifying training needs for biomedical equipment in a medical facility, the method comprising:
collecting identification and operation data associated with a plurality of biomedical equipment components;
storing the collected data in a central database;
analyzing the operation data to identify at least one operational parameter affected by operator activities with the equipment components; and
identifying a training need based on the analyzed operational parameter.

As set forth in the final clause of claim 1, the instant claim relates to a *need* for training, but not the mere presentation of a pre-existing training material. In other words, a need is something lacking but not yet satisfied, or a necessity arising from the

circumstances. Thus, “identifying a training need” can include recognizing this lack of training. Claim 1 also indicates that this identification of a training need is *based on the analyzed operational parameter*. Accordingly, the mere availability of pre-existing training materials, pre-scheduled training sessions, and other training materials may effectively train personnel, yet those personnel may not need that particular type of training. In other words, the mere availability of existing training information does not necessarily mean a particular need for training was ever recognized or identified in any manner.

Turning to the cited reference, Babula et al. disclose techniques for *servicing* a medical imaging system. See Babula et al., Title, Abstract; Col. 4, lines 33-35. In the Office Action, the Examiner cited several passages relating to training, yet these passages describe only pre-existing “schedules for training” and “scheduled or available training sessions.” See Babula et al., Col. 18, lines 46-49; Col. 19, lines 12-16. However, Babula et al. do not discuss any *identification* of a training *need*, much less one associated with an analyzed operating parameter, as recited by claim 1. Instead, the Babula et al. reference discloses *service* requests and responses to those service requests. In other words, Babula et al. facilitate servicing at a service facility by accessing a variety of information, such as routines, protocols, documentation, and schedules for training. See Babula et al., Col. 18, lines 30-54. Although Babula et al. disclose that this information “may be included in messages formulated by the service facility,” it does not necessarily flow that a training need ever existed or was identified. See Babula et al., Col. 18, lines 49-52. Instead, it appears that this information is simply provided as an *update*. See Babula et al., Col. 18, lines 46-49. In other words, when new routines or procedures exist, the user is informed of those changes regardless of any need for such information. See *id.* The Examiner has clearly misunderstood the missing feature of “identifying a training need,” as recited in claim 1. As discussed above, Babula et al. are completely silent regarding a *need* for training, much less the identification of such need. For this reason, the cited reference fails to anticipate independent claim 1 and its dependent claims.

Features of Independent Claim 15 Omitted from Babula et al.

The Examiner rejected claims 15-22 under 35 U.S.C. 102(e) as anticipated by Babula et al. Regarding independent claim 15, this claim recites:

A system for identifying training needs associated with a plurality biomedical equipment components in a medical institution, the system comprising:
a central database configured to store data representative of the equipment components, the stored data including operation data and identification data identifying at least an equipment type;
a data analysis module configured to arrange the operation data into logical groupings and to analyze the operation data based on the logical groupings, the logical groupings including an equipment type grouping; and
a report generator configured to generate a report including an arrangement of the analyzed operation data based on the logical groupings, wherein *a training need is identifiable based on the arrangement.*

Again, claim 15 is clearly directed toward *need*-based training, which is identified according to *analyzed* and *logically grouped* data associated with *equipment*. In this manner, the act of “identifying a training need” is not a mere identification of *existing* training material, but rather it is associated with *needs* that are discernible by means of the recited data feedback, data analysis, and logical groupings. The Examiner’s rejection cannot stand based on the mere existence of pre-existing training information without any identification of a need for that training information.

Turning to Babula et al., the Applicants reiterate that the disclosed servicing techniques do not identify a training need. Instead, the Babula et al. reference discloses *techniques for servicing*, including “suggestions for operating the diagnostic system,” “‘best practices’ type information for the particular system,” and alerts for “scheduled or available training sessions.” See Babula et al., Col. 19, lines 7-14. The Applicants stress that these servicing techniques are merely informational resources, which are unrelated to a particular

need for training. Again, a *need* relates to an unsatisfied lack of something. Babula et al. is does not disclose the presently claimed training need. In addition, independent claim 15 recites that the training need is *identifiable* based on an arrangement of analyzed operation data, which is based on logical groupings. However, Babula et al. do not teach any *identification* of a training need, much less identification based on an arrangement of operation data. For these reasons, the Babula reference cannot anticipate independent claim 15 and its dependent claims.

Features of Independent Claim 23 Omitted from Babula et al.

The Examiner rejected claims 23-27 under 35 U.S.C. 102(e) as anticipated by Babula et al. Claim 23 recites:

A method for identifying a training need associated with biomedical equipment in a medical institution, the method comprising:
storing data associated with the equipment in a central database, the stored data including equipment operation data and equipment identification data;
logically grouping the stored equipment operation data in accordance with the corresponding equipment identification data;
analyzing the equipment operation data based on the logical grouping;
generating a presentation of the analyzed equipment operation data in accordance with the logical grouping; and
identifying a training need associated with a particular piece of equipment based on the presentation.

Again, this independent claim 23 recites a training *need* and, specifically, the act of *identifying* a training need associated with equipment. As discussed above, the act of “identifying a training need” is not a mere offering or alerting of *existing* training material, but rather it relates to the act of recognizing or establishing that training is lacking or deficient for the particular piece of equipment. Although training materials may benefit all of those who use them, it does not necessarily flow that a need for training was ever

recognized or identified. Turning to the cited reference, Babula et al. only disclose pre-existing or prescheduled training sessions, which do not follow from any need for training. Thus, the Babula et al. reference cannot anticipate independent claim 23 and its dependent claims, because the reference does not disclose “*identifying a training need* associated with a particular piece of equipment based on the presentation,” as recited in claim 23.

Features of Independent Claim 28 Omitted from Babula et al.

The Examiner rejected independent claim 28 under 35 U.S.C. 102(e) as anticipated by Babula et al. Claim 28 recites:

A system for of identifying training needs for biomedical equipment in a medical facility, the method comprising:
means for collecting identification and operation data associated with a plurality of biomedical equipment components;
means for storing the collected data in a central database;
means for analyzing the operation data to identify at least one operational parameter affected by operator activities with the equipment components; and
means for identifying a training need based on the analyzed operational parameter.

Again, the Examiner’s rejection is deficient, because the Babula et al. reference does not teach or suggest “means for identifying a training need,” as recited cited by claim 28. As discussed above, needs are not necessary identified just because information is available that could satisfy the needs of some people. In Babula et al., training sessions are made available, yet the *need* for training is never disclosed or suggested. Accordingly, the Babula et al. reference does not anticipate independent claim 28.

For these reasons, the Applicants respectfully request that the Examiner withdraw all outstanding rejections under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as obvious over Babula et al. in view of Linberg et al. (U.S. Patent No. 6,497,655). Applicants respectfully traverse this rejection for the following reasons.

Request Removal of Commonly Assigned Reference under 103(c)/102(e)

Regarding the Babula et al. reference, the Applicants respectfully stress that Babula et al. (U.S. Patent No. 6,381,557) should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Babula et al. (U.S. Patent No. 6,381,557) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, General Electric Company. Accordingly, the Applicants respectfully request the Examiner remove Babula et al. (U.S. Patent No. 6,381,557) from consideration. After Babula et al. (U.S. Patent No. 6,381,557) is removed according to 35 U.S.C. § 103(c), the Examiner's rejection based on Babula et al. (U.S. Patent No. 6,381,557) is moot.

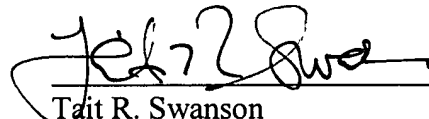
For these reasons, the Applicants respectfully request that the Examiner withdraw the rejection of claim 14 under 35 U.S.C. § 103(a).

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: June 30, 2004


Tait R. Swanson
Registration No. 48,226
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545